

REMARKS

By this Response, Applicants are responding to the Official Action dated April 27, 2004 in which the Examiner rejected claim 24 under the judicially created doctrine of double patenting over claim 1 of Sainton '453 (U.S. Patent No. 6,134,453). The Official Action also rejected claims 24-25 and 27-31 under 35 USC §102(e) as being anticipated by Bridges '197 (U.S. Patent No. 6,148,197); and claim 26 under 35 USC §103(a) as obvious in view of Bridges et al. '197 and Mueller '413 (U.S. Patent No. 6,185,413).

The specification has been amended to correct an inadvertent error in the identification of the second filed application in the family of applications on which this application claims priority under 35 USC §120. The prior identification was submitted as an amendment to the specification in a Second Preliminary Amendment filed on November 21, 2001. The inserted information stated that the second application (08/707,262; now Patent No. 5,854,985) was a "continuation-in-part" of the first filed application (08/167,003 filed on December 15, 1993). This is incorrect because the second application is actually a "continuation" of the first filed application. This same error was made when the third application (09/149,292; now Patent No. 6,134,453 to Sainton et al.) was issued. A Certificate of Correction has been issued correcting the error in the Sainton '453 patent. (See Attachment 1 filed with this amendment.) A typographic error in the number identifying the Sainton'453 patent has also been corrected. The subject application is related to U.S. Patent No. 5,761,621 for which two Reissue applications (09/392,676 and 10/737,670) have been filed.

This application has an effective filing date of December 13, 1993 under the provisions of 35 USC § 120 and 37 CFR § 1.78. In particular, the time periods for perfecting a claim to priority under 35 USC § 120 do not apply since this application was filed before November 29, 2000. See 37 CFR §1.78 (a)(2)(ii)(B) and the specification has been amended as required to be afforded the benefits of priority to all of the identified applications under 35 USC § 120. Should the Examiner believe that this application is not entitled to the benefit of the filing date of application 08/149,003 (that is December 15, 1993), he is requested to contact the undersigned at the telephone (or email address) listed below so that any deficiency can be promptly corrected.

By way of a separate Letter filed with this Response, the PTO has been asked to correct the filing receipt to correctly identify the Continuing Data relating to this application.

With respect to the Examiner's double patenting rejection, claim 24 is not "similar in scope with wording variations only" since claim 24 of this application relates to "user defined individual priority" which operates to define "which one of the wireless communication networks is accessed among the wireless communication networks that are determined by said adaptive control circuit to be available." This language contrasts with the limitations in claim 1 of Sainton'453 that relates to means for selecting a network for access based on the comparison of network "operating characteristics" to changeable user defined "criteria" including at least one of cost, quality, potential for being dropped and security. Nevertheless, Applicants have elected to overcome the subject double patenting rejection by filing a Terminal Disclaimer. Attached to this response is the Terminal Disclaimer, executed by the undersigned Attorney of Record, which disclaims the terminal part of any patent granted on this application that would extend the expiration date of the full statutory term of Sainton '453 patent. Applicants disagree with the statement in the Official Action that "there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into patent." The reason was that Applicants had failed to claim the subject matter that is now being claimed in claim 24 of this application and this subject matter is not of the same scope as claim 1 of Sainton '453 as noted above. The Examiner has made no attempt to explain how the "rare" circumstances of *In re Schneller*, 397 F. 2d 350 as referred to in 804 of the MPEP apply to the present circumstances. With the filing of the Terminal Disclaimer, Applicants believe that the rejection based on double patenting has been overcome.

The rejections of claims 24 through 31 based on the Mueller '413 patent and Bridges '197 patent are believed to be improper because neither reference meets the criteria for being prior art under 35 USC § 102 against the subject application. In particular, both of these references have filing dates (June 17, 1997 and March 6, 1998, respectively) that post date by over three years the earliest effective filing date (December 15, 1993) of the subject application. Accordingly, neither the Mueller '413 patent nor the Bridges '197 patent can qualify as prior art

against the subject application under §102(e) or any other subsection of §102. Applicants respectfully request that the rejections of claims 24 through 31 based on 35 USC 102(e) and 103 based on the Mueller '413 patent and the Bridges '197 patent be withdrawn.

Several of the other references cited as prior art by the Examiner similarly have effective dates that are too late for such references to qualify as prior art under 37 USC §102, i.e. 6,249,686 to Dvorkin et al.; 5,950,130 to Coursey; 5,903,832 to Seppanen et al.; and 6,418,318, 6,298,235, 6,311,064 and 5,905,955, all to Bamburak et al.

The patent to Barber et al (5,784,693) appears to attempt to give greater control to the network service provider and less control to the end user over automatic network selection. This functionality is the opposite of the function of the subject invention which seeks to maximize user control by allowing the end user to control the automatic selection process under by allowing the user to change the priority that is used to control automatic network selection.

The subject application is a continuation of the application on which US Patent No. 6,134,453 (cited by the Examiner) was issued and therefore this patent can not be prior art with respect to the claims of this application.

The status of the claims pending in this application is as follows:

Claims 24 through 106 are pending.

Claim 24 is rejected based on judicially created double patenting doctrine.

Claims 24-25 and 27-31 are rejected under 102 (e) in view of Bridges '197.

Claim 26 is rejected under 103(a) based Bridges '197 in view of Mueller '413.

Applicant is also submitting an Information Disclosure Statement to provide to the Examiner copies of Office actions received from the Canadian and European Patent Offices with respect to corresponding applications pending in these countries (Canadian App. 2,179,151 and European 95 908 417.9). The claims pending in the European application (95 908 417.9) relate generally to methods for frequency sharing among wireless networks and refer to prior art references (Vodafone EP A 0 501 807, Motorola WO90 13211 and US 5,127,042 to Gillig).

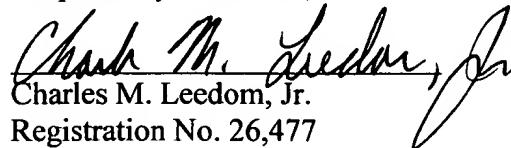
Accordingly these European claims are more relevant to the claims of related, commonly assigned Patent No. 5,761,621. The claims of the Canadian application include some claims directed to omni-modal circuitry appropriate for handsets and the first Canadian Official Action relies upon US 5,261,117 to Olsen and US 5,127,042 to Gillig et al. The Examiner is urged to carefully review these Official Actions and the cited prior art, copies of which were previously supplied.

The IDS being submitted also includes abstracts of arguments for invalidity of claims in the Sainton '453 patent put forth by prospective licensees identifying and applying prior art. Again the Examiner is urged to carefully consider this information. The Examiner's attention is specifically directed to Takahashi (6,058,316) which discloses stored criteria for controlling network selection. See particularly, col. 6, lines 41 through 55 but it is not clear that the user is empowered to change the stored criteria. Moreover, this reference fails to provide enabling disclosure for implementing the automatic network selection and accessing processes using circuitry as claimed in the subject application.

The Examiner's attention is further directed to Attachment 2 (Exhibit C) that identifies various inter parties matters relating to the patent rights held by MLR, LLC which include US Patent Nos. 5,854,985 and 6,134,453 on which the subject application claims priority. Other related patents such as Patent No. 5,761,621 and applications such as reissue applications based on Patent No. 5,761,621 are also listed in Attachment 3 (Exhibit A).

Re-examination and allowance of this application is respectfully requested.

Respectfully submitted,


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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,134,453
DATED : October 17, 2000
INVENTOR(S) : Joseph B. Sainton; Charles M. Leedom, Jr.; Eric J. Robinson

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It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title page.

Related U.S Application Data, item [60], please replace the paragraph:
"Division of application No. 08/707,262, Sep. 4, 1996, Pat. No. 5,854,985, which is a continuation-in-part of application No. 08/167,003, Dec. 15, 1993." with the following
-- Division of application No. 08/707,262, Sep. 4, 1996, Pat. No. 5,854,985, which is a continuation of application No. 08/167,003, Dec. 15, 1993. --

Signed and Sealed this

Sixteenth Day of October, 2001

Attest:

Nicholas P. Godici

Attesting Officer

NICHOLAS P. GODICI
Acting Director of the United States Patent and Trademark Office